

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1-17.

The following claim is *independent*: 1.

Please *amend* claims 1, 3 and 12; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 112

The Office Action has rejected claims 1-5, 7-11 and 13 under 35 U.S.C. 112, second paragraph as being unclear and rendering the claims indefinite (Office Action, § 3, page 2-6). The Office Action has further rejected claims 6, 12 and 14-17 as being dependent from rejected base claims (Office Action, § 3, page 6).

Applicant respectfully traverses these rejections. Although, Applicant disagrees with the Examiner's characterization of the claims and assertions, Applicant, in order to provide further clarification and correct typographical inaccuracies and/or informalities, and/or to

better track practical/commercial implementations/practices, has amended claims 1, 3 and 12.

Applicant notes, with regard to 35 U.S.C. 112, second paragraph, MPEP § 2173.02 prescribes:

definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (a). The content of the particular application disclosure;
- (b). The teachings of the prior art; and
- (c). The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

Applicant submits that the rejection in the pending Office Action does not establish any of these requirements.

Applicant disagrees with the Examiner's: (1) characterization of the claims; (2) assertion that the claims are allegedly omitting an essential step; and (3) that the gerunds used in the independent claim 1 are unsupported by the original specification and render the claims indefinite. Applicant submits that the terms and elements recited in the claims are clear and definite. Further, Applicant submits that the original specification, figures, claims and abstract clearly support the claims as pending. For example, the Examiner's alleged omitted element of "applying insider trading rules" is explicitly recited in claim 1, "[a] processor implemented method ... comprising ... processing the received information by applying insider trading rules to determine ..." as a substantive claim element (emphasis added).

Furthermore, Applicant notes MPEP 706 states that "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the

opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity" (MPEP § 706). Applicant further notes that the Examiner did not raise 35 U.S.C. § 112 rejections in the two previous office actions (Non-final Office Action dated February 25, 2008 and Final Office Action dated October 15, 2008) on the pending claims.

In view of the Examiner's assertions and the foregoing arguments, Applicant submits that the Examiner has failed to comply with MPEP § 2173.02. Accordingly, Applicant requests withdrawal of this ground of rejections, and reconsideration and allowance of the claims. Should the Examiner disagree, Applicant respectfully requests the Examiner provide additional clarification of the rejections describing specifically how and why the claimed elements would be allegedly vague and indefinite to one with ordinary level of skill in light of the application's originally filed disclosure.

Claim Rejections - 35 U.S.C. § 103

The Office Action has rejected claims 1-5, 7-11 and 14-16 under 35 U.S.C. 103(a) as allegedly being unpatentable over Goldschmidt (US Patent No. 6,983,266 B1) (hereinafter "Goldschmidt") in view of Barton et al. (US Patent Application No. 2002/0059093 A1) (hereinafter "Barton") (Applicant notes that the Examiner has erroneously listed claims 1-5, 7-11 and 14-17 instead of claims 1-5, 7-11 and 14-16). The Office Action has further rejected claims 6 and 17 (Applicant notes that the Examiner has erroneously listed claims 1-5, 7-11 and 14-17 instead of claims 6 and 17) under 35 U.S.C. 103(a) as allegedly being unpatentable over Goldschmidt in view of Barton in further view of Official Notice. Claims 12 and 13 are rejected under U.S.C. 103(a) as allegedly being unpatentable over Goldschmidt in view of Barton in

further view of Mastwyk et al. (US Patent Application No. 2002/0091622 A1) (hereinafter "Mastwyk"). Applicant respectfully traverses all of these rejections.

Applicant also respectfully traverses all two instances of Official Notice taken by the Examiner. Specifically, the Examiner takes Official Notice on page 11, § 6, asserting "banks, brokerages and national trades are old and well known sources for securities trading" (see Office Action, page 11, § 6). The Examiner also takes Official Notice on page 16, § 6, asserting "encryption, password protection, and biometric protection of secure data as well as an override capability for law enforcement agencies, administrators, and tech support personnel are old and well known in the art" (see Office Action, page 16, § 6). Applicant notes that MPEP §2106.II(C) prescribes, "USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation." Applicant submits that the Examiner has failed to evaluate the elements related to each of the instances of Official Notice within the context of their respective claims taken as a whole. As such, Applicant submits the claimed elements would not be "capable of instant and unquestionable demonstration as being well known" to one of ordinary skill in the art at the time the invention was made, within the context of the claimed invention, as required by MPEP §2144.03(A) to establish a possible basis for Official Notice. Therefore, Applicant respectfully traverses the Examiner's Official Notice (and any other instances of Official Notice in the pending Office Action) and requests that the Examiner provide explicit evidentiary support asserting that the claim element(s) is allegedly unquestionably demonstrable as being old and well known as one of ordinary skill in the art at the time of the invention would understand within the context of the claimed invention.

Accordingly, Applicants submit a prima facie case of obviousness has not been established. MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;

(B) the difference or differences in the claim over the applied reference(s);

(C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and

(D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicant submits that, by over-generalizing the applied references, the rejections in the Office Action do not establish at least either of the first two elements of a prima facie case of obviousness.

Amended independent claim 1 recites, *inter alia*:

A processor implemented method for the facilitation of monitoring of a transaction for one or more indications of insider trading, the method comprising:

receiving digital information related to pre-clearance of a financial transaction into a storage medium of a computer device;

processing the received information by applying insider trading rules to determine whether the financial transaction would violate the insider trading rules;

...

Applicant submits that the cited references, taken alone or in combination, do not discuss or render obvious at least these claim elements recited in independent claim 1.

The pending rejection alleges that Goldschmidt discusses :

"... Goldschmidt ... discloses a processor-implemented method ... of insider trading, the method comprising:

...
processing the digital information Goldschmidt ... col. 12, lines
20-28 ...

Applicant respectfully traverses and submits that Goldschmidt does not discuss or render obvious the claimed elements.

Instead of discussing the claimed elements, Goldschmidt discusses analyzing and processing historical data to determine if a past event was a non-compliant event. Specifically, Goldschmidt discusses retrieving an event producing an anomaly (Suspect Non-Compliant Event, SNCE) and associated data and information:

In the first step 100, SNCE and associated data and information is retrieved from the primary monitoring computer system. This information is stored on a blackboard (typically a database system is used for the blackboard).

(See, Goldschmidt, col. 7, lines 58-62)

The retrieved information is further processed by agents to determine if the suspect non-compliant event is actually a non-compliant event. In Goldschmidt, a team of agents —

... assists the ASX's [Australian Stock Exchange] surveillance analysts decision making task of classifying a SNCE generated by the primary monitoring system (SOMA [Surveillance of Market Activity])
(See, Goldschmidt, col. 12, lines 20-28)

If the agents determine that the event is actually a non-compliant event, the event is reported for further investigation or legal action.

Where there appears to have been a breach of the law, the matter is reported to the federal government body that administers the corporations law, namely the Australian Securities Commission (ASC) for further investigation and, if necessary, for legal action.
(See, Goldschmidt, col. 12, lines 47-51)

However, Applicant submits that Goldschmidt's compliance monitoring system detects a past suspect non-compliant event and uses a "fuzzy modeling" approach to

determine if the past suspect event was an actual non-compliant event. As such, Goldschmidt's system is based on past events that have occurred. Therefore, Goldschmidt does not discuss or render obvious the claimed "...receiving digital information related to **pre-clearance of a financial transaction**" let alone "...processing the received information by applying insider trading rules to determine whether the financial transaction would violate the insider trading rules" as explicitly recited in independent claim 1 (emphasis added).

Moreover, Applicant submits that Barton's method of identifying and quantifying compliance issues (Barton, Abstract) does not remedy at least these deficiencies in Goldschmidt, with regard to independent claim 1.

Applicant notes that MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis added]. Applicant submits that the pending rejection has failed to consider "every limitation in the claim" and "[a]ll words in [the] claim" in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). Accordingly, Applicant submits that a *prima facie* showing of obviousness has not been put forth and respectfully requests reconsideration and withdrawal of this basis of rejection.

For at least these reasons, Applicant respectfully submits claim 1 is not rendered obvious by Goldschmidt in view of Barton, taken alone or in combination. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejections.

Furthermore, Applicant submits that claims 2-17 which depend directly or indirectly from independent claim 1 are also patentably distinct from the cited references and the Official Notices, taken alone or in combination, for at least similar reasons to those deficiencies discussed above in the applied references with respect to independent claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejections.

CONCLUSION

Consequently, the references cited by the office action do not result in the claimed invention, there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-17, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements and/or bases for rejection were not discussed as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art and reserves the opportunity to more particularly traverse, remark and distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to an Office Action objection

and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Office Action objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-311CP1. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-311CP1.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
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